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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/057,794	01/24/2002	Ellen Chapman	99-40112-US-C1	1543

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EXAMINER

TOMASZEWSKI, MICHAEL

ART UNIT	PAPER NUMBER
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3626

DATE MAILED: 04/19/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 10/057,794	<b>Applicant(s)</b> CHAPMAN ET AL.	
	<b>Examiner</b> Mike Tomaszewski	<b>Art Unit</b> 3626	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 24 January 2002.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 13-35 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 13-35 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 22 August 2002 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Notice To Applicant***

1. This communication is in response to the application filed on 1/24/2002. Claims 13-35 are pending. Claims 1-12 have been cancelled.

### ***Claim Rejections - 35 USC § 103***

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 13-35 are rejected under 35 U.S.C. 103(a) as being unpatentable over Luchs et al. (4,831,526; hereinafter Luchs), in view of Eisenmann (5,459,304; hereinafter Eisenmann).

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(A) As per claim 13, Luchs discloses a system for generating at least one of an insurance cancellation certificate, an insurance renewal certificate, or proof of insurance, from at least one remote computer terminal connected by a computer network to a central computer, the system comprising:

- (1) at least one remote computer terminal (Luchs: abstract; col. 2, line 56-col. 3, line 17; Fig. 1-11F);
- (2) a central computer (Luchs: abstract; col. 2, line 56-col. 3, line 17; Fig. 1-11F);
- (3) a database stored on the central computer in which data relating to at least one insurance policy is stored (Luchs: abstract; col. 2, line 56-col. 3, line 17; Fig. 1-11F);
- (4) software embodied in computer code configured to enable the at least one remote computer terminal to interact with the data stored in the database (Luchs: abstract; col. 2, line 56-col. 3, line 17; Fig. 1-11F);
- (5) a communicative connection connecting the at least one remote computer terminal with the central computer (Luchs: abstract; col. 2, line 56-col. 3, line 17; Fig. 1-11F);
- (6) wherein the software lists, for review by a user of the at least one remote computer terminal, a list of at least one expiring insurance policy corresponding to the data stored in the database (Luchs: abstract; col. 3, lines 5-16; col. 5, lines 33-50; Fig. 1-11F); and

- (7) wherein the software enables the user of the at least one remote computer terminal to control, in response to the review of at least a portion of the at least one expiring insurance policy, the local printing of at least one of the insurance cancellation certificate, the insurance renewal certificate, or proof of insurance relating to one or more of the at least one expiring insurance policy, from the at least one remote computer terminal (Luchs: abstract; col. 2, line 56-col. 3, line 17; col. 4, lines 48-59; col. 7, lines 5-27; col. 11, line 28-col. 12, line 41; Fig. 1-1F).

Luchs, however, fails to expressly disclose a system for generating at least one of an insurance cancellation certificate, an insurance renewal certificate, or proof of insurance, from at least one remote computer terminal connected by a computer network to a central computer, the system comprising:

- (8) wherein the software uses flags to flag a list of expiring insurance policies.

Nevertheless, this feature is old and well known in the art, as evidenced by Eisenmann. In particular, Eisenmann discloses a system for generating at least one of an insurance cancellation certificate, an insurance renewal certificate, or proof of insurance, from at least one remote computer terminal connected by a computer network to a central computer, the system comprising:

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- (8) wherein the software uses flags to flag a list of expiring insurance policies (Eisenmann: abstract; col. 5, line 31-col. 6, line 33; Fig. 1-13D).

One of ordinary skill would have found it obvious at the time of the invention to combine the teachings of Eisenmann with the teachings of Luchs with the motivation of providing an efficient computerized insurance system (Luchs: col. 2, lines 21-26).

(B) As per claim 14, Luchs discloses the system of claim 13, wherein the insurance cancellation certificate, the insurance renewal certificate, or the proof of insurance corresponds to insurance for a vehicle (Luchs: abstract; Fig. 1-11F).

(C) As per claim 15, Luchs discloses the system of claim 14, wherein the vehicle is an automobile (Luchs: abstract; col. 5, lines 10-12; Fig. 1-11F).

(D) As per claim 16, Luchs fails to expressly disclose the system of claim 14, wherein the vehicle is considered a "black car."

Examiner, however, respectfully submits that "black cars" (i.e., luxury passenger cars for hire) and other for-hire vehicles, such as, "silver cars," taxicabs, livery cars, limousines, and the like, are well known and obvious. Moreover, the practice of insuring these vehicles, just as insuring any other generic vehicle for that matter, and producing the requisite documents (e.g., insurance cancellation certificate, insurance renewal certificate, proof of insurance, etc.) to this end is well known and obvious.

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One of ordinary skill would have found it obvious at the time of the invention to combine this practice with the combined teachings of Luchs and Eisenmann with the motivation of offering vehicular insurance (Luchs: abstract).

(E) As per claim 17, Luchs fails to expressly disclose the system of claim 13, wherein the insurance cancellation certificate is a standardized insurance termination certificate in accordance with an FH4 form.

Examiner, however, respectfully submits that FH4 forms and the technique of abiding the law by creating documentation that is in accordance with the law (e.g., creating standardized insurance documentation in accordance with a FH4 form, etc.) is well known and obvious.

One of ordinary skill would have found it obvious at the time of the invention to combine this technique with the combined teachings of Luchs and Eisenmann with the motivation of offering vehicular insurance (Luchs: abstract).

(F) As per claim 18, Luchs fails to expressly disclose the system of claim 13, wherein the insurance renewal certificate is a standardized insurance renewal certificate in accordance with an FH1 form.

Examiner, however, respectfully submits that FH1 forms and the technique of abiding the law by creating documentation that is in accordance with the law (e.g., creating standardized insurance documentation in accordance with a FH1 form, etc.) is well known and obvious.

One of ordinary skill would have found it obvious at the time of the invention to combine this technique with the combined teachings of Luchs and Eisenmann with the motivation of offering vehicular insurance (Luchs: abstract).

(G) As per claim 19, Luchs fails to expressly disclose the system of claim 13, wherein the proof of insurance is a standardized proof of insurance certificate.

Examiner, however, respectfully submits that proof of insurance and the technique of developing standardized proof of insurance is well known and obvious.

One of ordinary skill would have found it obvious at the time of the invention to combine this technique with the combined teachings of Luchs and Eisenmann with the motivation of offering vehicular insurance (Luchs: abstract).

(H) As per claim 20, Luchs discloses the system of claim 13, wherein the at least one remote computer terminal comprises an interface, and wherein the interface displays the list for review by the user of the at least one remote computer terminal (Luchs: abstract; col. 2, line 56-col. 3, line 17; Fig. 1-11F).

Luchs, however, fails to expressly disclose a flagged list. Nevertheless, this feature is old and well known in the art, as evidenced by Eisenmann. In particular, Eisenmann discloses the system of claim 13, wherein the at least one remote computer terminal comprises an interface, and wherein the interface displays the flagged list (Eisenmann: abstract; col. 5, line 31-col. 6, line 33; Fig. 1-13D).



One of ordinary skill would have found it obvious at the time of the invention to combine the teachings of Eisenmann with the teachings of Luchs with the motivation of providing an efficient computerized insurance system (Luchs: col. 2, lines 21-26).

(I) As per claim 21, Luchs discloses the system of claim 13, wherein the list is generated automatically (Luchs: abstract; col. 3, lines 5-16; col. 5, lines 33-50; col. 29, lines 65-67; Fig. 1-11F).

Luchs, however, fails to expressly disclose the system of claim 13, wherein a flagged list is generated. Nevertheless, this feature is old and well known in the art, as evidenced by Eisenmann. In particular, Eisenmann discloses the system of claim 13, wherein a flagged list is generated (Eisenmann: abstract; col. 5, line 31-col. 6, line 33; Fig. 1-13D).

One of ordinary skill would have found it obvious at the time of the invention to combine the teachings of Eisenmann with the teachings of Luchs with the motivation of providing an efficient computerized insurance system (Luchs: col. 2, lines 21-26).

(J) As per claim 22, Luchs discloses the system of claim 13, wherein the list is generated automatically on a periodic basis (Luchs: abstract; col. 3, lines 5-16; col. 5, lines 33-50; col. 29, lines 65-67; Fig. 1-11F).

Luchs, however, fails to expressly disclose the system of claim 13, wherein a flagged list is generated. Nevertheless, this feature is old and well known in the art, as evidenced by Eisenmann. In particular, Eisenmann discloses the system of claim 13,

wherein a flagged list is generated (Eisenmann: abstract; col. 5, line 31-col. 6, line 33; Fig. 1-13D).

One of ordinary skill would have found it obvious at the time of the invention to combine the teachings of Eisenmann with the teachings of Luchs with the motivation of providing an efficient computerized insurance system (Luchs: col. 2, lines 21-26).

As per the limitation of "on a periodic basis," Examiner respectfully submits that the technique of performing acts (e.g., generating lists, etc.) at predefined time intervals (e.g., periodic basis, daily basis, etc.) is old and well known. One of ordinary skill in the art would have found it obvious at the time of the invention to combine this technique with the combined teachings of Luchs and Eisenmann with the motivation of providing an efficient computerized insurance system (Luchs: col. 2, lines 21-26).

(K) As per claim 23, Luchs discloses the system of claim 13, wherein the list is generated automatically on a daily basis (Luchs: abstract; col. 3, lines 5-16; col. 5, lines 33-50; col. 29, lines 65-67; Fig. 1-11F).

Luchs, however, fails to expressly disclose the system of claim 13, wherein a flagged list is generated. Nevertheless, this feature is old and well known in the art, as evidenced by Eisenmann. In particular, Eisenmann discloses the system of claim 13, wherein a flagged list is generated (Eisenmann: abstract; col. 5, line 31-col. 6, line 33; Fig. 1-13D).

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One of ordinary skill would have found it obvious at the time of the invention to combine the teachings of Eisenmann with the teachings of Luchs with the motivation of providing an efficient computerized insurance system (Luchs: col. 2, lines 21-26).

As per the limitation of "on a daily basis," Examiner respectfully submits that the technique of performing acts (e.g., generating lists, etc.) at predefined time intervals (e.g., periodic basis, daily basis, etc.) is old and well known. One of ordinary skill in the art would have found it obvious at the time of the invention to combine this technique with the combined teachings of Luchs and Eisenmann with the motivation of providing an efficient computerized insurance system (Luchs: col. 2, lines 21-26).

(L) As per claim 24, Luchs discloses the system of claim 13, wherein the software runs on the central computer (Luchs: abstract; col. 3, lines 5-17; Fig. 1-11F).

(M) Claims 25-35 substantially repeat the same limitations as those of claims 13-24 and are therefore, rejected for the same reasons given for those claims and incorporated herein.

### ***Conclusion***

4. The prior art made of record and not relied upon is considered pertinent to Applicant's disclosure. The cited but not applied art teaches a system and method for automatically generating automobile insurance certificates from a remote computer

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terminal (6,526,386); a method of verifying insurance on registered vehicles (5,325,291); and a system and method for automated risk-based pricing of a vehicle warranty insurance policy (6,182,048).

The cited but not applied prior art also includes non-patent literature articles by Newman, Andy ("Change In Taxi Code Seen As Unlikely To Pass Intact" May 28, 1998. New York Times. pg. B.3.); Sengupta, Somini ("Commuters Brace For Cab-Less Wednesday As Drivers Protest" May 13, 1998. New York Times. pg. B.1.); Houston Chronicle ("Senate Oks Surveys On Auto Coverage" May 1, 1999. pg. 2.); State of New York Insurance Dept. ("Increased Minimum Limits For Bodily Injury Liability And Personal Injury Protection For Public Autos..." Aug 6, 1998. Circular Letter No. 18 (1998).); State of New York Insurance Dept. ("Worker's Compensation Insurance: 'Black Car' And 'Silver Car' Operations" May 3, 2001.); NYC Taxi & Limousine Commission ("Information Guide" @ [www.NYC.gov/taxi](http://www.NYC.gov/taxi)); and New York State Dept. of Motor Vehicles ("Motor Vehicle Dealers & Transporters Regulations" @ [www.nysdmv.com](http://www.nysdmv.com)).

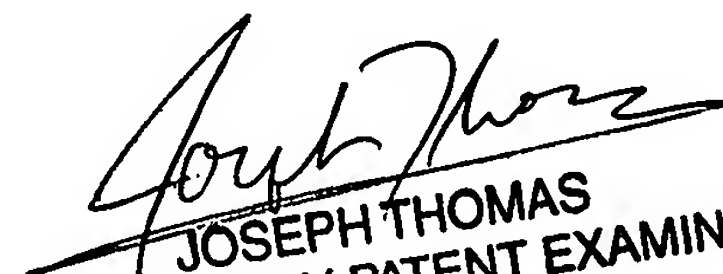
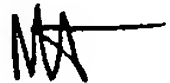
5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mike Tomaszewski whose telephone number is (571)272-8117. The examiner can normally be reached on M-F 7:00 am - 3:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph Thomas can be reached on (571)272-6776. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

MT



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